



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/765,633 | 01/22/2001 | Masato Ageta | 1086.1135/JDH | 8778 |

21171 7590 03/29/2004

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

| |
|----------|
| EXAMINER |
|----------|

LUU, SY D

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2174

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,633

Applicant(s)

AGETA ET AL.

Examiner

Sy D Luu

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002 and 22 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-5, 17-18, and 24-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for developing a menu corresponding to the application on a screen using stored menu information, does not reasonably provide enablement for a predetermined menu on the screen if an application which does not store said menu information is started or no application is started. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. In this instance, it is not at all clear as well as comprehensible to have a situation where the menu development unit develops “a predetermined menu on the screen if an application which does not store said menu information is started or no application is started” as recited in claims 4, 17 and 24.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2174

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 6-16, 19-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi (JP-01100620).

As per claims 1-3 and 6, Higuchi teaches an information processing apparatus comprising: a menu storage unit storing characteristic menu information corresponding to menu items, a menu development unit discriminating an application which is now started and developing a menu corresponding to the menu item on a screen using said menu information, a

Art Unit: 2174

menu execution unit executing a processing corresponding to a menu item selected from said menu, and if the application for which said menu information exists is started, the application is activated (figs. 1 and 7; page 1-2).

While Higuchi teaches menu items being generic, Higuchi does not expressly disclose the menu items to be applications. Official Notice is taken that menu items on a screen could be any type of selectable objects including applications to be activated. It would have been obvious to an artisan at the time of the invention to apply Higuchi's menu items to instances where menu items are applications in order to provide means for selecting and activating a specific and desired application.

As per claim 7, Higuchi further teaches an indication unit indicating development of said menu, and said menu development unit discriminates the started application if indication of said indication unit is detected (fig. 1; page 1, last paragraph – page 2, first paragraph).

As per claims 8-9 and 12-13, Higuchi teaches said indication unit to be a device consisting of a scrawl up/down buttons for changing selection of the menu item from said menu and defined button for determining the selected menu item, wherein said defined button is operated to thereby indicate the development of said menu (fig. 1; keys 3-6 and 7), wherein said indicative unit is provided in front of a keyboard, and wherein the information processing apparatus consists of: a cover on which a display is arranged, a main body on which said keyboard is arranged, and a coupling section coupling the cover to the main body (fig. 1).

As per claims 10-11, all claimed features regarding the arrangement of the defined button as well as the scrawl up/down buttons being a seesaw switch are well known in the art. It would have been obvious to an artisan at the time of the invention to include such features with

Art Unit: 2174

Higuchi's apparatus in order to provide convenient and efficient means for navigating through - as well as selecting menu options.

Claims 14-16 and 19-20 are similar in scope to claims 1-3 and 6-7 respectively, and are therefore rejected under similar rationale.

Claims 21-23 and 25-27 are similar in scope to claims 1-3 and 6-7 respectively, and are therefore rejected under similar rationale.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tanigawa et al. (US 6,314,570)

Allision et al. (US 6,262,722)

Dow et al. (6,160,926)

Nakano et al. (US 5,708,787)

Inquires

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is (703) 305-0409. The examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



**SY D. LUU
PRIMARY EXAMINER**